

REMARKS

The Applicant appreciates the interview conducted on August 12, 2008 between the Examiner and the Applicant's representative. A discussion of the references and an apparent failure to provide a reason for the rejection of claim 17 were discussed. Also, the election of species was discussed. The Examiner and Applicant's representative failed to reach agreement on a claim amendment that would overcome the cited references, but the Examiner did indicate that any amendments or arguments submitted by the Applicant after final would be considered by the Examiner.

Applicant expressly withdraws previous arguments and assertions, but not the amendments, and relies on the present response for overcoming the objections and rejections of the Office Action mailed July 1, 2008. An amendment has been made to the Abstract for formal matters overcoming the objections made in the Office Action mailed July 1, 2008.

All of the claims have been amended to correct formalities. No new matter has been added by any of the amendments to the claims or abstract.

In addition, claim 12 has been amended by incorporating a limitation from claim 17 into claim 12, which now reads on the elected species. The Applicant reserves the right to file a continuation or divisional application claiming unelected subject matter.

The Amendments to claims 14 and 15 are supported by the drawings and the specification.

Claims 16 to a non-elected species and claim 17 are now cancelled. All of the pending claims are now drawn to the elected species.

New claims 23-25 are added, depending from claim 21 and incorporating the limitations from claim 21 as previously presented. No new matter is added by the new claims.

New claim 26 is added, depending from claim 12. The limitation of claim 26 is supported by the drawings of the elected species. No new matter is added by the addition of new claim 26.

Entry of the amendments to the claims and the Abstract is requested, which amendments put the application in condition for allowance.

Claims 12, 14-15 and 18-26 are now pending.

35 U.S.C. §103

Applicant respectfully traverses the rejection of the pending claims under 35 U.S.C. §103, because none of the references cited, taken alone or in combination, teach or suggest all of the limitations of the pending claims, as hereby amended.

Nothing in DiMatteo et al. teaches or suggests the following missing element: “a plurality of gear teeth securely fixed on the blade and extending radially outward from the pivot axis,” which is recited in amended claim 12 for each of the pair of blades. In order to establish *prima facie* obviousness under 35 U.S.C. §103, a single cited reference or a combination of cited references must teach or suggest all of the limitations of a claim, and there must be some reason that a person of ordinary skill in the art would combine the elements found in more than one cited reference. Specifically, DiMatteo et al., taken alone or in combination with any of the other cited references, fails to teach or suggest the missing element; therefore, the Office Action fails to establish *prima facie* obviousness over claim 12, as amended. For this reason, claim 12 is patentable over the cited references, and all of the pending claims, which depend from claim 12 are likewise patentable over the cited references. The Office Action asserts the following:

between the two handles (paragraph 26). It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the arms (14), and thus the blades (30), of Van Keppel et al. to be on offset axes and meshed with two gears in order to evenly distribute the load encountered while cutting a cigar between the two lever arms in view of the teachings of DiMatteo et al. Examiner notes that the gears are directly mounted on the blades (as disclosed by DiMatteo et al.), but not integral with the blades. There are no parts in between the gear assembly and the blade units, and thus they are directly mounted on the blades.

Applicant respectfully traverses this assertion for several reasons: it does reflect a proper interpretation of the scope of the claims as previously presented or as now amended, and even if a reason existed for a person of ordinary skill to combine the cited references, Van Keppel et al. expressly teaches away from just such a combination.

The Applicant traverses the claim interpretation suggested in the Office Action for claim 12 as previously presented. The assertion excerpted above uses the language “directly mounted on the blades,” but claim 12, as previously presented recited that the tooth portions are “directly secured ... to each of [the pair of] blades.” The specification at page 6, lines 25-35, provides support for this limitation, and it is clear from the specification that “secured” means fixed on the blade, because when force is applied to the blade the gears must be able to mesh and to cause a cooperative displacement, simultaneously and symmetrically, of one blade with the other. Thus, “directly secured ... to each of [the pair of] blades” cannot be interpreted to mean only that the tooth portion are “directly *mounted* on the blades” as suggested by the Office Action in the above excerpt. This interpretation is overly broad, rewrites the claim, and fails to consider the claim within the context of the specification.

Furthermore, in item 1 on page 10 and 11 of the amendment and response of March 25, 2008, the Applicant clearly and unequivocally explained the difference between the teeth being secured directly to the blade and the teachings of DiMatteo in detail, disclaiming any broader interpretation. This clear and unequivocal disclaimer of claim scope was ignored in the most recent Office Action. Thus, the meaning of the claim as amended in the response of March 25, 2008 was improperly broadened beyond the meaning clearly and unequivocally adopted by the Applicant. Applicant respectfully requests withdrawal of the rejection made in the Office Action mailed July 1, 2008, which was based on an improper and overly broad interpretation of claim 12 that fails to consider the claims within the context of the specification and the prosecution history.

Furthermore, even accepting a broader definition for “directly,” DiMatteo shows gear portions 34, 36 secured on the ends of handles 12, 14, which are not fixed securely on the blades 20, 22. Indeed, the handles 12, 14 are mounted on extension members from the blades 20, 22. And fasteners 28, 30 connect the extension members of the blades 20, 22 to the handles 12, 14 at a distance from the gear portions 34, 36. This is best seen in Figures 2 and 3 of

DiMatteo. Thus, both the portion of the handles 12, 14 between the gear portions 34, 36 and the point of connection 28, 30 with the ends of the blade extensions and the blade extension on the opposite side of the pivot axis of the blades 20, 22 separate the gear portions 34, 36 from the blades 20, 22. For this reason, there is no direct connection between the gear portions 34, 36 of DiMatteo and the blades 20, 22. Thus, the gear portions 34, 36 are not at all secured to the blades 20, 22. Indeed, the lopping shears of DiMatteo would be completely inoperable if the gear portions 34, 36 were secured to the blades 20, 22 instead of being secured on the ends of the handles 12, 14, as shown in DiMatteo.

Currently amended claim 12 recites "...a plurality of teeth securely fixed on the blade..." Let there be no doubt that "securely fixed" means that a plurality of teeth do not move relative to its respective blade, and the Applicant hereby disclaims any other interpretation of claim 12. Thus, this limitation is neither taught nor suggested by DiMatteo et al. or any other cited reference, and the Office Action fails to establish *prima facie* obviousness over amended claim 12.

DiMatteo et al. teaches away from any other configuration of the handles, pivot points and blades. The purpose of the mechanical gearing is to provide for foldable lopping shears that safely store the blades within the handles during storage, improving safety and reducing the size of the stored lopping shears, compared to the operating configuration, without reducing the mechanical advantage provided by the long handles and the pivot point joining the two blades. DiMatteo cites these reasons in distinguishing prior art lopping shears.

Arguendo, even if there is some reason to combine the teachings of DiMatteo et al. and Van Keppel et al., Van Keppel et al. teach away from any kind of mechanisms that "...tend to be more complex and costly and, due to their complexity, may have excessive weight and size for hand use," as disclosed in the Background of the Invention by Van Keppel et al. Instead, Van Keppel distinguishes its invention from prior art cigar cutters having such complex mechanisms. See column 1, lines 22-26. Indeed, the object of the invention disclosed in Van Keppel is intended to address the shortcomings of such prior art devices by providing a compact and lightweight cigar cutter capable of being held in the palm of one hand, which provides "...a more comfortable and more powerful cutting action," as disclosed in column 1, lines 35-39. Thus, Van Keppel et al. expressly teach away from any combination with the

DiMatteo. For this reason, also, no person of ordinary skill in the art would look to the teachings of DiMatteo to modify the invention of Van Keppel, which teachings of DiMatteo would necessarily increase the complexity, cost, weight and size of the cigar cutter of Van Keppel. Thus, claim 12 is nonobvious over Van Keppel and DiMatteo.

In addition, none of the references cited teach or suggest “a means for connecting together the pair of blades ... a pair of connecting elements operatively engaging ... pivot axes of the pair of blades ... and the pair of connecting elements are spaced apart such that the plurality of gear teeth ... operatively meshes ...” with the other gear teeth, both of the gear teeth being securely fixed to their respective blades, as recited in claim 12 as amended. In order to establish *prima facie* obviousness, a reference or a combination of references must teach or suggest all of the claim limitations. None of the cited references, taken alone or in combination, teach all of these limitations of claim 12; therefore, the cited references fail to establish *prima facie* obviousness over claim 12.

The method of claim 22 is nonobvious over the cited references, because none of the references teach or suggest the method of using the device of claim 12, as recited in claim 22.

Claim 18 is rejected over Van Keppel in view of DiMatteo and Eiichi et al.; however, Eiichi et al. fails to teach or suggest any of the limitations of claim 12 omitted by Van Keppel and DiMatteo. Therefore, claim 18, which incorporates all of the limitations of claim 12 and additional limitations is nonobvious.

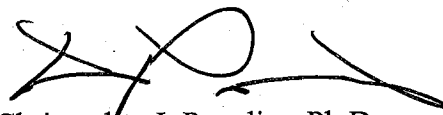
Now referring to new claims 23-26, claims 23-26 depend from claim 12 incorporating all of the limitations of claim 12 and additional limitations; therefore, claims 23-26 are nonobvious.

In addition, none of the cited references teach or suggest “...wherein the plurality of gear teeth is limited to two gear teeth per each of the pair of blades,” as recited in new claim 26. Thus, claim 26 is nonobvious for this reason, also. It would not be obvious to limit the number of gear teeth shown in DiMatteo to two teeth per gear, because the gears would be inoperable.

The Applicant respectfully requests entry of all of the amendments and the new claims.
The application and claims are now in condition for allowance.

Dated: August 28, 2008

Respectfully submitted,



Christopher J. Paradies, Ph.D.

Registration No.: 45,692

FOWLER WHITE BOGGS BANKER P.A.

501 East Kennedy Blvd., Suite 1700

Tampa, Florida 33602

Telephone: (813) 222-1190

CJP:kat

40388626v1